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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,495	02/04/2002	Benjamin A. Horenstein	UF-266X	7011

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EXAMINER

WEBER, JON P

ART UNIT PAPER NUMBER

1651

DATE MAILED: 03/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/067,495	Applicant(s) HORENSTEIN ET AL.	
	Examiner Jon P Weber, Ph.D.	Art Unit 1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/24/02, 8/19/02</u> . | 6) <input type="checkbox"/> Other: _____ |

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Election/Restrictions

Applicant's election of Group I, claims 1-15 and the species R1, R2, R3, R4, R5, R6, and R7 equal hydrogen; R8 equals cytidine monophosphate (R8=R9, wherein B is cytosine and m=1); X equals carbon; Y equals nitrogen; and Z equals carbon in the Paper filed 09 January 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claim 16 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group, there being no allowable generic or linking claim. Election was made **without** traverse. It is suggested that the non-elected claim 16 be canceled in response to this Office action to expedite prosecution.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 3-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Prinzbach et al. (1965).

Prinzbach et al. (1965) disclose compound XI on page 141.

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Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Gassman et al. (1966).

Gassman et al. (1966) disclose compounds 5-8 and 11-12 on page 2253.

Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Avram et al. (1969).

Avram et al. (1969) disclose compound 27 at page 4013.

Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by McDonald et al. (1970).

McDonald et al. (1970) disclose compounds 9, 12 and 19 at page 2667.

Claims 1-2 and 4-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Gilbert et al. (1976).

Gilbert et al. (1976) disclose compounds 11a and 11b at page 3884, column 2.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Boswell et al. (1977).

Boswell et al. (1977) disclose compounds 3, 5 and 6 at page 2342.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Dehmlow et al. (1978).

Dehmlow et al. (1978) disclose compounds 3a-d at pages 584 and 585.

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Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Scharf et al. (1978).

Scharf et al. (1978) disclose compounds 12-15 at page 172.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Gillespie et al. (1979).

Gillespie et al. (1979) disclose compound 5 at Table 1, page 2024.

Claims 1-3, 8-10, 12 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Achini et al. (US 4,235,921).

Achini et al. (US 4,235,921) disclose the compounds of Examples 2 and 3.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Baird (1981).

Baird (1981) discloses compound 6 at page 4064 and compounds 10-13 at page 4068.

Claims 1-2, 7-11 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by MacInnes et al. (1983).

MacInnes et al. (1983) disclose compounds 1a, 1b, 2 and 3 at page 2771.

Claims 1, 4-6 and 8-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Tufariello et al. (1987).

Tufariello et al. (1987) disclose compounds 10a,b and 11a,b at page 268.

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Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Wiberg et al. (1991).

Wiberg et al. (1991) disclose compounds 10 and the products of schemes 10 and 11 at page 7972; and compound 1 and reaction products at page 7974.

Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Lautens et al. (1994).

Lautens et al. (1994) disclose compounds 30d, 31b and 31d at page 8531.

Claims 1, 3-6, 8-10 and 12-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Marinozzi et al. (1995).

Marinozzi et al. (1995) disclose compounds 7, 8, 13 and 14 at page 328.

Claims 1, 3-6, 8-10 and 12-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Hercouet et al. (1996).

Hercouet et al. (1996) disclose compound 7 at page 1267.

Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Ezquerra et al. (1996).

Ezquerra et al. (1996) disclose compound 15 at page 2616.

Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Diaz et al. (1996).

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Diaz et al. (1996) disclose compound 5 at page 3466 and compounds 20a, 21a, 21b and 22 at page 3469.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Dulayymi et al. (1998).

Dulayymi et al. (1998) disclose compound 4 at page 12897.

Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Lescop et al. (5 May 2000).

Lescop et al. (5 May 2000) disclose compounds 21a and 21b at page 2997.

No claims are allowed.

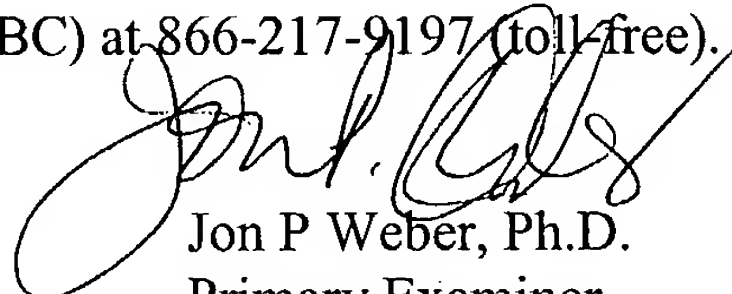
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon P Weber, Ph.D. whose telephone number is 571-272-0925.

The examiner can normally be reached on daily, off 1st Fri, 9/5/4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).



Jon P Weber, Ph.D.
Primary Examiner
Art Unit 1651

JPW
12 March 2004